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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/230,083 04/20/94 KRAUS

W TRW21364

QM02/1124

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EXAMINER

JOYCE, H

ART UNIT

PAPER NUMBER

3749

DATE MAILED:

11/24/00

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Patent and Trademark Office
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 34

Application Number: 08/230,083
Filing Date: April 20, 1994
Appellant(s): KRAUS, WILLIBALD

Michael E. Hudzinski
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed October 4, 2000.

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3749

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments after Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 14 and 16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3749

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14 and 16 are rejected under the equitable "recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. This rejection is set forth in prior Office Action, Paper No. 30.

(11) Response to Argument

Applicant has an erroneous assessment on pages 10 and 11, that under *In re Clement* the surrendered subject matter is the subject matter of original claim 1 because MPEP 1412.02 states:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

In the instance case, as viewed from applicant's **Table I**, the last six lines of Patent Claim 1 was surrendered.

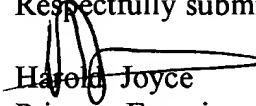
Additionally the Examiner's position is set forth in the prior Office Action, Paper No.

30.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Harold Joyce
Primary Examiner
Art Unit 3749

HJ
November 20, 2000

YES
LINDA SHALL
CONFERENCE


conference

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ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "*Changes to Implement the Patent Business Goals*", 65 *Fed. Reg.* 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 99, 110, 135, 139 (September 19, 2000).